

REMARKS

The Office Action rejects all of pending claims 1-14, and Applicants file the present paper in the hopes of clarifying several of the grounds of rejection to place the application in better form for appeal, or preferably to avoid the need for an appeal altogether because, as explained below, Applicants submit that the pending claims are in condition for allowance.

Independent Claim 1 and Dependent Claims 2-11

The Office Action relies entirely on Dwek (U.S. Patent No. 6,248,946) to reject independent claim 1 as being anticipated under 35 U.S.C. 102(e). Applicants had previously asserted that Dwek failed to teach or suggest the claim 1 “association links,” which are recited in the claim as follows:

... association links linking categories located at different levels in the hierarchical tree so that a user can traverse the tree by viewing a first media object in a first category at a first level in the tree, and then directly viewing a second object in a second category at a second level in the tree, where the first and second categories do not have a parent and child relationship in the tree.

In response, the Office Action refers to Dwek Fig. 3A, submitting that:

the manipulation of the first playlist [e.g., “PLAYLIST 1” in the figure] and SONG 3, for example, may be performed without directly proceeding through the parent of SONG 3. The media objects may be manipulated at will, and the second playlist [e.g., “PLAYLIST 2” in the figure] does not necessarily need to be manipulated to access SONG 3.

Office Action, p. 8.

Applicants are uncertain what feature, exactly, from Dwek is alleged to be the claimed “association link.” As far as Applicants can tell, Dwek offers no such link between PLAYLIST 1 and SONG 3, and does not describe the “manipulation” proposed by the Office Action. Indeed, the only “link” shown in Fig. 3A is the line passing through PLAYLIST 2

(SONG 3's "parent"). Furthermore, Dwek fails to teach or suggest the traversal recited in the claim (e.g., "travers[ing] the tree by viewing a first media object in a first category at a first level in the tree, and then directly viewing a second object in a second category at a second level in the tree.").

The Office Action does not allege that such a link, and such a traversal, are expressly taught by Dwek. It cannot, because Dwek never mentions such a manipulation of PLAYLIST 1 and SONG 3. Instead, the Office Action merely states that the proposed manipulation "may" be performed without proceeding through the parent of SONG 3, and that the media objects "may" be manipulated at will. The mere fact that a reference does not prohibit a feature from being present does not mean that feature is present for purposes of 35 U.S.C. 102. Such a fact isn't even enough to establish a teaching by inherency: "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP 2112(IV) (citing In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 (quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Dwek fails to teach the claimed association link, either expressly or by inherency, and Applicants submit that this rejection should be reconsidered and withdrawn, and claim 1 be allowed to issue. Furthermore, since there is no offered reason for modifying Dwek to exhibit the type of association link contemplated in the Office Action (e.g., a link going from PLAYLIST 1 to SONG 3 without going through PLAYLIST 2), an alternative rejection under 35 U.S.C. 103 would also not be proper.

Claims 2-11 depend from claim 1, and are allowable for at least the same reasons as claim 1. For example, dependent claim 7 recites a thumbnail, and “an integer number of frames being separated one from the other by intervening frames in the original video or film.” The Office Action relies on Stefik, et al., col. 8, lines 15-32 for such features. That portion of Stefik et al., however, is silent as to “an integer number of frames being separated one from the other by intervening frames in the original video or film,” as recited in claim 7. For example, Applicants are uncertain what integer number is being relied on for this rejection.

Furthermore, Applicants note that the Office Action maintains its combination of Dwek and Stefik et al. Applicants have two points in response. First, the Office Action alleges that “[i]n Dwek, there exists a desirability for thumbnail objects showing excerpts of the media objects to be requested so that the nature of a media object may be deciphered, without actually accessing the media object.” Office Action, p. 9. The Office Action cites nothing from Dwek to support this allegation, and Applicants find none in this reference. Indeed, Dwek deals with songs, and never mentions the need for a “thumbnail” of a song. Second, Dwek’s system is a program downloaded onto a desktop computer (Dwek prefers a desktop with the WINDOWS™ operating system – col. 14, lines 36-37), while Stefik et al.’s device is a portable device intended for use “autonomously from a computer based system.” Stefik et al., col. 2, lines 32-34. One patent is on a computer; the other one is separate from a computer; and neither patent offers any actual motivation for making the combination proposed in the Office Action. Applicants submit that there is no proper motivation, in the cited prior art, for the Office Action’s combination, and that the combination is the result of impermissible hindsight.

Independent Claim 12 and Dependent Claims 13-14

The Office Action relies on the same teachings from Dwek discussed above in claim 1 to reject independent claim 12. As discussed above, Dwek does not actually teach or suggest the feature cited by the Office Action, and accordingly, it fails to teach or suggest the claim 12 method.

Claims 13 and 14 depend from claim 12, and are allowable for at least the same reasons as claim 12. Furthermore, the Office Action's rejection of claim 14 appears to gloss over the claim language, and is ambiguous. The claim recites:

at least one of the association links will permit a user who is accessing a media object associated with the first associated node to directly access a second associated node, without accessing a parent node of the first associated node, but will not permit a user who is accessing a media object associated with the second associated node to directly access the first associated node without accessing a parent node of the first associated node

Applicants are uncertain exactly what aspect of Dwek is alleged to be the "first associated node," and what aspect is alleged to be the "second associated node," and where Dwek allegedly shows permitting the recited direct access in one direction, but not permitting it in the other. The only concrete examples given in the Office Action appear later, at p. 8, where the Office Action refers to Dwek requiring access of playlist when going from SONG 3 to SONG 1, but in this case the Office Action fails to explain why such access would not be required when going from SONG 1 to SONG 3. Applicants respectfully submit that there is no teaching or suggestion in Dwek for the claim 14 association link.

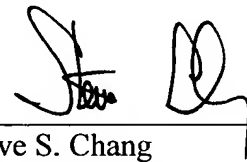
Conclusion

For at least the reasons set forth above, Applicants submit that the rejections of pending claims 1-14 are improper, and respectfully request reconsideration and withdrawal of the same

so that the case may proceed to issue. However, should the Examiner feel that additional discussion and/or amendment is needed to place the application in condition for allowance, the Examiner is invited to telephone the Applicants' undersigned representative at the number appearing below.

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Respectfully submitted,



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